

In the United States Patent and Trademark Office

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Appeal No: 2005-0378
Serial No: 09/232,566
Appn. Filed: 01/15/99
Applicant: Rolf Jansen
Appn. Title: Tractor/Trailer Back-up Kit
Examiner/GAU: Tung Vo/2613

Mailed: 01-18-06

At: Houston, Texas

SUBMITTAL OF APPELLANT'S REPLY BRIEF

Sir:

More than 4 months have passed since the PTO received on September 8, 2005, the Appellant's 2nd Supplemental Brief, and the appellant has not received a copy of an Answer from the examiner.

When at an earlier time the PTO received the Appellant's 1st Supplemental Brief, the appellant never received a copy of an Answer from the examiner.

When the appellant first discovered that the examiner had filed an Answer (more than 2 years earlier), it was too late for the appellant to file a Reply brief.

To make sure that situation does not happen to the appellant again, he files herewith Appellant's Reply Brief, in triplicate, in accordance with 37 CFR Section 1.193(b)(1), and submits check for \$250.00, the small entity fee for filing a brief.

Appellant's Reply Brief gives additional evidence and argument to rebut the examiner's rejection of claim 3 on Section 103 grounds, in Office Action mailed June 22, 2005.

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BEST AVAILABLE COPY

Petition to Make Special, for Reason IV-Applicant is over 65 years of age, was granted 11/27/04. He is now age 72.

Very respectfully,

Rolf Jansen

Rolf Jansen, appellant, pro se

P.O. Box 73161

Houston, TX 77273-3161

281-440-6907

Verification

Appellant, Rolf Jansen, pro se, hereby declares that all statements made herein of his own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this verified statement is directed.

Rolf Jansen

Rolf Jansen, appellant, pro se

Date of signature: 01-18-06

Certificate of Mailing

I certify that this correspondence will be deposited with the United States Postal Service as first class mail with proper postage affixed in an envelope addressed to: "Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" on the date below.

Date: 01-18-06

Rolf Jansen

Rolf Jansen, appellant, pro se

In the United States Patent and Trademark Office

Appeal No: 2005-0378
Serial No: 09/232,566
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Appn. Title: Tractor/Trailer Back-up Kit
Examiner/GAU: Tung Vo/2613

Mailed: 01-18-06
At: Houston, Texas

APPELLANT'S REPLY BRIEF

Applicant/appellant, Rolf Jansen, pro se, wishes to inform the Board of Patent Appeals and Interferences as follows:

1

Petition to Make Special, for Reason IV-Applicant is over 65 years of age, was granted 11/27/04. He is now age 72.

2

More than 4 months have passed since the PTO received on September 8, 2005, the Appellant's 2nd Supplemental Brief, and the appellant has not received a copy of an Answer from the examiner.

When at an earlier time the PTO received the Appellant's 1st Supplemental Brief, the appellant never received a copy of an Answer from the examiner.

When the appellant first discovered that the examiner had filed an Answer (more than 2 years earlier), it was too late for the appellant to file a Reply brief. (Further details are given in Appellant's 2nd Supplemental Brief, section 10, pages 9-11.)

To make sure that situation does not happen to the appellant again, he files herewith Appellant's Reply Brief, in triplicate, in accordance with 37 CFR Section 1.193(b)(1), and

submits check for \$250.00; the small entity fee for filing a brief.

Appellant's Reply Brief gives additional evidence and argument to rebut the examiner's rejection of claim 3 on Section 103 grounds, in Office Action mailed June 22, 2005.

3

There is nothing in the prior art of Ernst (DE 33 16 818) and Lee (US 5,680,123) about a display assembly that clips onto the driver's sun visor. The clip-on display assembly is a novel and useful feature of claim 3. This feature is described in the specification, pages 10, 19, 36; and copy of said pages is attached as Exhibit 1. Relevant sentences are marked on the pages.

Certain properties are inherent in use of a clip -- namely, easy attachment and easy detachment of the assembly from the driver's sun visor.

For example: These properties allow the assembly to be quickly moved from one truck tractor to another, or, to be easily taken to a safer place, away from risk of theft, if the truck tractor is to be parked unattended for an extended time.

In comparison, the display assembly in Ernst is built into the passenger's sun visor. And the display assembly in Lee is built into the center of the dashboard.

Furthermore, the clip-on display assembly of claim 3 is simpler, and therefore, less costly to make and install, than the more complex display assemblies of Ernst and Lee.

In re Wright, 6 USPQ2d 1959, 1962 (Fed. Cir. 1988), a copy of which is attached as Exhibit 2, the Court of Appeals held that:

"Factors including unexpected results, new features, solution of a different problem, novel properties, are all considerations in the determination of obviousness in terms of U.S.C. section 103." (Emphasis added.)

The above quote is found on page 1962, beginning at line 16.

4

In Appellant's 2nd Supplemental Brief, the appellant gave evidence and arguments that the examiner's decision to reject claims 3 and 4 should be reversed by the Board of Patent Appeals and Interferences.

In Appellant's Reply Brief additional evidence and argument are given pertaining to claim 3.

WHEREFORE, the appellant very respectfully requests that the Board of Patent Appeals and Interferences:

1. Reverse the examiner's decision rejecting claims 3 and 4.
2. Order the examiner to allow claims 3 and 4, as written, within a specific time limit that the Board determines is appropriate, taking into consideration that the appeal from Final Rejection was initiated by the appellant on June 28, 2001, and the appellant is now age 72.

The appellant also requests general relief.

Very respectfully,

Rolf Jansen

Rolf Jansen, appellant, pro se

P.O. Box 73161

Houston, Texas 77273-3161

281-440-6907

Verification

Appellant, Rolf Jansen, pro se, hereby declares that all statements made herein of his own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this verified statement is directed.

Rolf Jansen

Rolf Jansen, appellant, pro se

Date of signature: 01-18-06

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Date: 01-18-06

Rolf Jansen

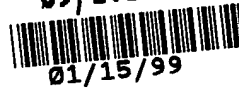
Rolf Jansen, Appellant, pro se

The following received today:

Patent Application for Rolf Jansen for
"Tractor/Trailer Back-up Kit", consisting of
39 sheets specification, claims, and
abstract, declaration signed 1999 Jan.15,
5 sheets formal drawing, small entity declar-
ations (2 of them), and check nr. 978 for
\$395.00:

JC530 U.S. PTO

09/232566



01/15/99

Patent Application of
Rolf Jansen
for
TRACTOR/TRAILER BACK-UP KIT

Background - Field of Invention

This invention relates to closed-circuit television, specifically to an improved means, when backing, for a driver of a tractor/trialer rig, or other motor vehicle, to see what is to the rear when the unaided view is obstructed.

Background - Cross-Reference to Related Application

This application claims the benefit of Provisional Patent Application Ser.# 60/071,830, filed January 20, 1998.

Background - Description of Prior Art

I was an adjuster for an independent claims service that specialized in on-the-scene accident investigations for motor freight lines that were self-insured; and the most common accident occurred when a tractor/trailer rig was being backed.

When the trailer is the rectangular-box type, the driver can

Heavy cotton denim, of the kind used to make stone-washed blue jeans, insulates well from heat and cold. I made a case of this material to cradle the CITIZEN 2.9 inch LCD monitor. There is a window in the case for the monitor screen. The case is made wide enough to enclose the plugs and cables that fit into power and video jacks to the LCD monitor.

On the back of the case is a sewn patch with a slot to fit a banker's clasp, which is a long, thin clip of sufficient length to extend the entire vertical length of the sunvisor, and hold the denim case securely.

I designed the denim case to have a seamless underbody, a soft, rounded form that cradles the LCD monitor and aids in absorbing vibrations.

When the sunvisor-mounted case is in the UP position, the monitor is further insulated by the overhead lining, the interior side of the vehicle roof.

Also, the use of a portable sunscreen to cover the interior of the windshield when the vehicle is parked in the summer sun can diminish buildup of heat.

Getting the mirror image

One more thing needs to be done to really increase the effectiveness of the sunvisor-mounted camcorder-type LCD monitor. The image in the screen needs to be a mirror image, like looking in a rear view mirror.

If such an image is possible, then the driver facing forward sees in the monitor screen (when the sunvisor is lowered) what

and power jacks on the left side of the monitor. This keeps the plugs from coming loose, hides unsightly wires; and the extended space gives a looseness that aids in absorbing vibrations. The extended section is shown in Fig. 4.

A separate patch of cloth 14, as shown in Fig. 2, is sewn to the back of the denim case 30. This patch provides a vertical slot, for inserting a long, thin metal clip, called a banker's clasp 16, that can be purchased from Acco USA, Inc., Wheeling, Illinois.

This thin, metal clasp, long enough to extend the whole vertical depth of a motor-vehicle sunvisor, securely holds the case, with monitor, to the retracted side of the sunvisor; and holds the case and monitor securely when the sunvisor 22 (as shown in Fig. 3) is lowered, and the monitor is in front of the face of the truck driver.

As shown in Fig. 3, the video and power supply cables that extend from the left top of the denim case, through the gap where the top flap folds over, are wrapped in spiral wrap 28, obtainable from RadioShack, to make one organized strand, rather than two loose strands of wire. The video and power supply lead cables, with plugs, come with the monitor when purchased.

As shown in Fig. 2, the top flap 20 that folds over is attached by a 1/4" wide strip of Velcro 18 that extends the length of the flap. Opening of the top flap allows the monitor to be put in or taken out of the case.

The video cable and power supply cable, coming from the monitor, and made one strand by spiral wrap, follow the contours

embodiment thereof. Many other variations are possible. For example:

A case is a form of covering. A covering could be fixed to the outside of the monitor itself.

The case or covering could be made of a variety of materials that provide insulation.

Means for mounting the case to the sunvisor can vary, e.g., the shape, size, and material of the clip or clasp can vary; the clip or clasp could be attached by an adhesive backing.

The rear plate, to which the enclosure for the micro-video, pin-holed lens camera is mounted, need not be a license plate but could be a plate with a company logo on it, or with a phrase on it, such as Drive Safely.

The means for mounting the enclosure on the back side of the plate can vary, e.g., by using machine screws, and washers, rather than epoxy glue, as long as weather-proof integrity of the enclosure was maintained. (I chose to epoxy glue the enclosure to the plate so no screw heads and washers would show on the front side of the plate, to add to concealment.)

The pane that attaches to the front face of the enclosure could be made of another material besides LEXAN XL. The dimensions of the pane could vary.

Also the dimensions, material, and color of the enclosure could vary.

Accordingly, the scope of the invention should be determined not by the embodiment(s) illustrated, but by the appended claims and their legal equivalents.

In the United States Patent and Trademark Office

EXHIBIT 1

6 PAGES

Mailed 199 9, Jan 15

Box Patent Application
Assistant Commissioner for Patents
Washington, District of Columbia 20231

Fee Transmittal

First-Named Applicant Rolf Jansen
Title of Invention: "Tractor/Trailer Back-up Kit"
Total Payment Enclosed (From Calculation Below): \$ 395.00 ☒ Check ☐ Money Order

Sir:

Enclosed is the following small entity filing fee for the above patent application:

Fee Code	Fee Description	Fee (\$)
214	Provisional Pat. Appn. Filing Fee	
201	Basic Utility Appn. Filing Fee	<u>395.00</u>
206	Basic Design Appn. Filing Fee	
	Subtotal (1)	<u>395.00</u>
203	Total Claims: _____ - 20 = _____; X _____ (fee for each claim over 20) =	<u>N/A</u>
202	Tot. Indep. Claims _____ - 3 = _____; X _____ (fee for each indep. claim over 3) =	<u>N/A</u>
	Subtotal (2)	
Total Payment Enclosed [Sum of Subtotals (1) and (2)]		<u>395.00</u>

Very respectfully,

Rolf Jansen
Signature of First-Named Applicant

Rolf Jansen
Print Name of First-Named Applicant

P. O. Box 73161
Address

Houston, TX 77273

different from those in the instant appeal. In *Trust* the attorney switching firms contacted his former client to inform him of the possible conflict. The attorney also provided files to his former client to assist the former client in determining if he wished to object to the representation. The former client promised to contact the attorney if he objected to the representation but he waited two and one-half years before bringing an objection.

In contrast to the facts in *Trust*, the facts in the instant appeal do not indicate an intent by Seagate to waive its right to object to representation of Atasi by the Skjerven firm. Kallman did not contact Seagate to inform it of the possible conflict. Instead Karl Limbach⁸ learned of the conflict from a telephone call to Kallman. Seagate did not promise to contact Kallman if Seagate objected to the representation and the motion to disqualify was brought about 6 months after Seagate learned of the conflict. During this 6 months the proceedings and discovery had been stayed and the motion was brought on the same day Atasi moved to lift the stay.

In addition to the facts, we must consider the policies involved. The doctrine of waiver exists as a means to balance the competing policies relevant to imputed disqualification. The policy of preserving the former client's confidences is opposed by the policy of giving the opposing party the freedom of choice of legal counsel. See *Model Rules of Professional Conduct* Official Comments to Rule 1.10. (1983).⁹ The doctrine of waiver protects the opposing party's freedom of choice of legal counsel. However waiver should only apply where, on the facts present, the balance of the competing policies weighs in favor of the opposing party's freedom of choice of legal counsel. This occurs particularly when a motion to disqualify is used in an abusive manner as a part of litigation tactics. This occurred in *Trust*. Since the type of abuse present in *Trust* is not present in the instant appeal there is no waiver.

Atasi will undoubtedly suffer in time and expense as a result of the disqualification of the Skjerven firm. This is particularly unfortunate since it is the attorney's actions, not Atasi's, which resulted in the disqualification. It was Kallman and the Skjerven firm,

not Atasi, who knew of the possible conflict.¹⁰ On the former client's side it was Limbach, not Seagate, who first learned of the conflict of interest.

Though Atasi will undoubtedly suffer as a result of the imputed disqualification of the Skjerven firm, that alone is insufficient to prevent the disqualification. Again, there are competing policies affecting the disqualification rule and a balancing is necessary to determine which policy should have priority. Whenever a result is reached by choosing one policy over another the party in favor of the subordinated policy usually suffers. In the instant appeal the policy of preserving the former client's confidences is entitled to priority over the policy of freedom of choice of counsel.

CONCLUSION

Appellant had the burden of showing an absence of "any sound" basis in the record to support the district court's order. Finding neither legal error nor abuse of discretion in the order of the district court, we affirm.

AFFIRMED

Court of Appeals, Federal Circuit

In re Wright

No. 87-1464

Decided May 24, 1988

PATENTS

1. Patentability/Validity — Obviousness — In general (§115.0901)

Patent and Trademark Office erred in denying on grounds of obviousness patent for carpenter's level which had as its primary purpose improved pitch-measuring capability over prior art but which incorporated prior art of internal pin to improve visibility of level bubble, since obviousness determinations under 35 USC 103 must include consideration of invention as whole, including its structure, its properties, and problem it

⁸ A partner in the firm of Limbach, Limbach, & Sutton, Seagate's counsel after the Flehr firm withdrew.

⁹ The Model Rules have not been adopted by California or the Northern District of California but Rule 1.10 relating to imputed disqualification and the official comments thereto are instructive in the instant appeal.

¹⁰ As part of a settlement agreement in a prior action (*Atasi v. Priam*) the Flehr firm was prohibited from representing Seagate in the instant case. Thus Atasi deprived Seagate from freedom of choice of counsel.

solves, and thus unobviousness of level's structure for its intended purpose is relevant to obviousness determination.

Appeal from Board of Patent Appeals and Interferences' rejection of claims 1 through 8 of patent application, serial no. 399,850, of Randall J. Wright. Reversed.

Robert W. Slater and Jones, Day, Reavis & Pogue (Robert L. Lindgren, on brief), Chicago, Ill., for appellant.

Lee E. Barrett, associate solicitor (Joseph F. Nakamura, solicitor and Fred E. McKelvey, deputy solicitor, on brief), for appellee PTO.

Before Friedman, Newman, and Mayer, circuit judges.

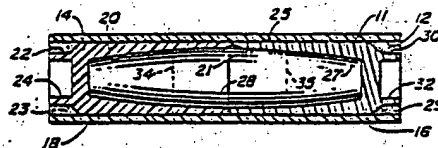
Newman, J.

The judgment of the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office, rejecting claims 1 through 8 of patent application Serial No. 399,850 of Randall J. Wright for "Level Vial with Extended Pitch Range", is reversed.

The Invention

Instruments that are commonly called carpenter's levels have long been known. They used small liquid-filled transparent vials with an entrained gas bubble; the vials function by gravity, the bubble automatically seeking the highest point within the vial. The vial is attached to a support, such that when the surface on which the support is placed is level, the bubble is centered. Thus, the position of the bubble shows the orientation of the vial and of the support.

Levels in common use today are made from barrel-shaped vials, mounted so that the bubble may be viewed from either side of the vial. An example of a barrel-shaped vial set in a molded plastic housing is shown in Vaida U.S. Patent No. 3,871,109, of record:



These levels of the prior art are limited in their pitch measuring capability because of the limited amount of curvature that can be formed in the molded barrel vial shape.

The pitch is the degree to which a given surface is not level. "Pitch" vials measure a range of pitch angles.

The Wright invention is a level-measuring instrument that has an increased range of pitch measurement capability, yet retains the advantages of the barrel vials of the prior art. Claim 1 is representative:

1. A level vial comprising a body having a bore formed with a barrel shaped portion having opposed ends and wherein the barrel curvature is defined by a first radius of curvature,

the barrel shaped portion of the bore having a cross-sectional dimension generally decreasing from the center thereof in axially opposed directions towards the ends thereof,

an axially elongated core member disposed within the bore and between the opposed ends thereof in coaxial relationship with the barrel shaped portion of the body and having a maximum cross-sectional dimension and having a second radius of curvature exceeding that of the first radius of curvature of the barrel shaped bore portion,

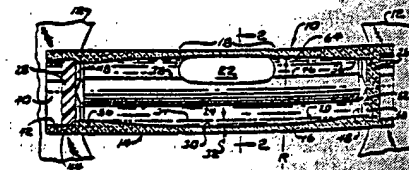
a quantity of fluid disposed within the bore and being insufficient to fill the bore and to provide a bubble therein having a dimension sufficient to simultaneously contact the surfaces of the barrel shaped bore portion and the core member;

means for hermetically sealing the bore to contain the fluid and to maintain the bubble therein,

the vial body having a transparent portion and indicator means associated therewith to permit visual bubble observation and for indicating preselected positions of the bubble in the vial

and wherein the surfaces of the barrel shaped bore portion and the core member coact with the bubble to produce gradual bubble movement axially within the barrel shaped bore portion without abrupt bubble acceleration and while providing a wide range of visually observable angular measures.

The Wright structure is illustrated as follows:



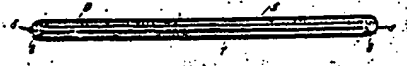
According to the Wright disclosure, by combining a core pin (46) and a barrel vial (14), the indicator bubble (22) does not move as far along the barrel with a given change in pitch, compared with the barrel vials of the prior art. Wright illustrates this phenomenon in his specification (showing a pitch change of 3/8 inch per 12 inches):



Thus the Wright level can measure greater changes of pitch before the bubble reaches the end of the vial.

The Rejection

The Board agreed with Wright that his claimed combination was new. However, because it was known to place a core pin in a cylindrical vial in order to increase the visibility of the bubble, as shown in Bishop U.S. Patent No. 771,803:



the Board held that it would have been obvious to construct a level having a core pin in the barrel-shaped vial of Vaida, irrespective of the purpose. The Commissioner on appeal argued that the Bishop and Vaida references presented, in combination, a prima facie case of unpatentability, stating:

[A] claimed invention may be unpatentable if it would have been obvious for reasons suggested by the prior art, even though those reasons may be different from the reasons relied upon by the inventor and may result in a different advantage.

The PTO position is that since it would have been obvious to make the Wright combination in order to improve visibility of the bubble, it is immaterial that Wright's combination improves pitch measurement.

Discussion

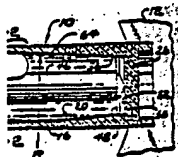
The Commissioner argues that if it is obvious to combine the teachings of prior art references for any purpose, they may be combined in order to defeat patentability of the applicant's admittedly new structure.

The PTO states that "a claimed invention may be unpatentable if it would have been obvious for reasons suggested by the prior art, even though those reasons may be different from the reasons relied upon by the inventor and may result in a different advantage." The PTO position is that it is irrelevant that Wright's structure was for a purpose, and has properties, that are neither obtainable from the prior art structures, nor suggested in the prior art. In this lies the PTO's error.

We repeat the mandate of 35 U.S.C. §103: it is the invention as a whole that must be considered in obviousness determinations. The invention as a whole embraces the structure, its properties, and the problem it solves. See, e.g., *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1025, 226 USPQ 881, 886 (Fed. Cir. 1985) ("In evaluating obviousness, the hypothetical person of ordinary skill in the pertinent art is presumed to have the 'ability to select and utilize knowledge from other arts reasonably pertinent to [the] particular problem' to which the invention is directed"), quoting *In re Antle*, 444 F.2d 1168, 1171-72, 170 USPQ 285, 287-88 (CCPA 1971); *In re Antonie*, 559 F.2d 618, 619, 195 USPQ 6, 8 (CCPA 1977) ("In delineating the invention as a whole, we look not only to the subject matter which is literally recited in the claim in question . . . but also to those properties of the subject matter which are inherent in the subject matter and are disclosed in the specification") (emphasis in original).

The determination of whether a novel structure is or is not "obvious" requires cognizance of the properties of that structure and the problem which it solves, viewed in light of the teachings of the prior art. See, e.g., *In re Rinehart*, 531 F.2d 1048, 1054, 189 USPQ 143, 149 (CCPA 1976) (the particular problem facing the inventor must be considered in determining obviousness); see also *Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984) (it is error to focus "solely on the product created, rather than on the obviousness or nonobviousness of its creation") (quoting *General Motors Corp. v. U.S. Int'l Trade Comm'n*, 687 F.2d 476, 483, 215 USPQ 484, 489 (CCPA 1982), cert. denied, 459 U.S. 1105 (1983)).

Thus the question is whether what the inventor did would have been obvious to one of ordinary skill in the art attempting to solve the problem upon which the inventor was working. *Rinehart*, 531 F.2d at 1054, 189 USPQ at 149; see also *In re Benno*, 768 F.2d 1340, 1346, 226 USPQ 683, 687 (Fed. Cir.



1985) ("appellant's problem" and the prior art "present different problems requiring different solutions").

[1] The problem upon which Wright was working was improving the pitch-measuring capability of the level, not the visibility of the bubble. The PTO, having conceded that Wright's structure was unobvious for his intended purpose, erred in holding that this was not relevant. The problem solved by the invention is always relevant. The entirety of a claimed invention, including the combination viewed as a whole, the elements thereof, and the properties and purpose of the invention, must be considered.

Factors including unexpected results, new features, solution of a different problem, novel properties, are all considerations in the determination of obviousness in terms of 35 U.S.C. §103. When such factors are described in the specification they are weighed in determining, in the first instance, whether the prior art presents a prima facie case of obviousness. See, e.g., *In re Margolis*, 785 F.2d 1029, 1031, 228 USPQ 940, 942 (Fed. Cir. 1986) (comparative data in the specification must be considered in PTO determination of unexpected results, as part of 'the entire body of evidence . . . which must be weighed in the first instance by the PTO.') When such factors are brought out in prosecution before the PTO, they are considered in determining whether a prima facie case, if made based on the prior art, has been rebutted. See, e.g., *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 789 (Fed. Cir. 1984) (rebuttal evidence is considered along with all other evidence of record). In either case, the requisite view of the whole invention mandates consideration of not only its structure but also its properties and the problem solved.

Applicant Wright agrees that he has combined old elements. The Commissioner agrees that Wright has achieved a new combination, and that the result obtained thereby is not suggested in the references. The patentability of such combinations is of ancient authority. See, e.g., *Prouty v. Draper*, 41 U.S. (16 Pet.) 336, 341 (1842); *Eames v. Godfrey*, 68 U.S. (1 Wall.) 78, 79-80 (1863); *Gill v. Wells*, 89 U.S. (22 Wall.) 1, 25 (1874); see also H.T. Markey, *Why Not the Statute?*, 65 J. Pat. Off. Soc'y 331, 333-34 (1983) ("virtually all inventions are 'combinations', and . . . every invention is formed of 'old elements' . . . Only God works from nothing. Man must work with old elements").

The PTO position that the claimed structure is prima facie obvious is not supported by the cited references. No reference shows

or suggests that properties and results of Wright's claimed structure, or suggests the claimed combination as a solution to the problem of increasing pitch measurement capacity. It is not pertinent whether Wright's new structure also has the prior art attribute of increased visibility of the bubble; for that is not his invention.

The Commissioner on appeal defends the fact that the Board and the examiner never reached this analysis. The Board relied on *In re Wiseman*, 596 F.2d 1019, 201 USPQ 658 (CCPA 1979), to support the Board's statement:

If the claimed subject matter would have been obvious from the references, it is immaterial that the references do not state the problem or advantages ascribed thereto by appellant.

Wiseman does not support the generalization that the Board attributes to it. In *Wiseman* the prior art reference showed a similar problem and suggested a similar solution to that of the applicant. Specifically, the prior art showed a disc brake having grooves for the purpose of venting dust generated during use; the applicant showed a disc brake having grooves for the purpose of venting steam generated during use. The applicant asserted no results or properties that were not fairly suggested by the prior art. The court's discussion in *Wiseman* must be viewed in context, and as with all section 103 decisions, judgment must be brought to bear based on the facts of each case.

Conclusion

The rejection of claims 1 through 8 was in error. The Board's decision is
REVERSED

District Court, M.D. North Carolina

Yates-American Machine Co. Inc. v.
Newman Machine Co. Inc.

No. C-86-958-G

Decided February 22, 1988

PATENTS

1. Practice and procedure in U.S. Patent and Trademark Office — Re-issue — In general (§110.1301)

JUDICIAL PRACTICE AND PROCEDURE

Procedure — Motions (§410.31)

Stay of suit seeking declaration of non-infringement, invalidity, and/or unenforceability

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Mayer, Roc
Leydig, Voil
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Kleemeier,
Greensboro,

John J. Barnh
Park & Gi
defendants.

Ward, C.J.

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Plaintiff Yates
Inc. [Yates] is a N

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